

## REMARKS

This Reply and Amendment is in response to the Office Action mailed on July 11, 2006 in which claims 1-18 and 25-41 were rejected. Applicant respectfully requests reconsideration of the present application in view of the above amendments and the reasons that follow.

### 1. Rejection of Claims 1-10 and 25-41 Under 35 U.S.C. § 112

On Page 2 of the Office Action, the Examiner rejected claims 1-10 and 25-41 under 35 U.S.C. § 112, second paragraph, “because the Applicant is positively claiming two separate shafts (a shaft and a replacement shaft) and the problem that the Examiner has is that one shaft replaces the other one and it seems like the claimed joint prosthesis has two shafts at the same time.” Applicant has amended independent claims 1, 25, and 41 (and corresponding dependent claims as necessary) to respond to the rejection. As recognized by the Examiner, Applicant does not wish to claim a joint prosthesis having two shafts installed at one time. Applicant has amended claim 1 to state “a plurality of modular shafts including a first shaft coupled to the body and extending through the central canal into a bone of the patient and a second replacement shaft, wherein the first shaft is interchangeable after implantation of the prosthesis by removing the first shaft from the bone and replacing the first shaft with the second replacement shaft . . . .” Applicant has amended claim 25 to state “a plurality of modular shafts comprising a first shaft extending into a bone and configured to be coupled to the body and a second replacement shaft configured to be coupled to the body, wherein the second replacement shaft is used to replace the first shaft . . . .” Applicant has amended claim 41 to state “a plurality of modular shafts including a first shaft extending at least partially through the central canal into a bone and an intramedullary nail configured to be inserted into the central canal to replace the first shaft . . . .”

Applicant respectfully submits that the amendments to claims 1, 10, and 41 resolve the issues cited by the Examiner in the rejection under 35 U.S.C. § 112 and requests that the rejection be withdrawn.

**2. Rejection of Claims 1-3, 5-13, 15-18, 25-27, 30-33, 35, and 40 Under 35 U.S.C. § 102(e) as Anticipated by Ganjianpour**

On pages 3-4 of the Office Action, the Examiner rejected claims 1-3, 5-13, 15-18, 25-27, 30-33, 35, and 40 as anticipated by Ganjianpour, U.S. Patent No. 6,716,250. In response to the rejection, Applicant has amended independent claims 1, 11, 25, and 41. Applicant respectfully requests reconsideration of claims 1-3, 5-13, 15-18, 25-27, 30-33, 35, and 40 in view of the above amendments and the following reasons.

Independent claim 1, as amended, recites “a plurality of modular shafts” including “a first shaft coupled to the body and extending . . . into a bone of the patient” and “a second replacement shaft,” and further that “the first shaft is interchangeable after implantation of the prosthesis by removing the first shaft from the bone and replacing the first shaft with the second replacement shaft without dislodging the body from the patient.” (Emphasis added.) On page 4 of the Office Action, the Examiner refers to element 26 of Ganjianpour as the “shaft” and element 30 of Ganjianpour as the “replacement shaft.” Neither element 26 nor element 30 of Ganjianpour extend into a bone of a patient as recited by claim 1, as amended. In contrast, element 26 extends into the “stem 13” and element 30 extends into element 26 and partially into the “stem 13.” Even if the “stem 13” of Ganjianpour were considered to correspond to the “first shaft,” the “stem 13” is not removable “without dislodging the body from the patient” as recited in independent claim 1. Therefore, Ganjianpour does not identically disclose each of the elements of claim 1, as amended. Accordingly, independent claim 1 and corresponding dependent claims 2-10 and 40 are not anticipated by Ganjianpour and are presented for reconsideration and allowance.

Similar to claim 1, independent claim 11, as amended, recites “a shaft coupled to the body and extending into a long bone of the patient,” independent claim 25 recites “a first shaft extending into a bone,” and independent claim 41 recites “a first shaft extending . . . into a bone.” For at least the same reasons as identified for claim 1 above, claims 11, 25, and 41 (and

corresponding dependent claims 12-18 and 26-39) are not anticipated by Ganjianpour and are presented for reconsideration and allowance.

**3. Rejection of Claims 3-4, 14, 28-29, and 36-39 Under 35 U.S.C. § 103(a) Based Upon Ganjianpour in View of Pennig**

On pages 4-5 of the Office Action, the Examiner rejected claims 3-4, 14, 28-29, and 36-39 under 35 U.S.C. § 103(a) as unpatentable over Ganjianpour in view of Pennig, U.S. Patent No. 5,375,956. As discussed above, independent claims 1, 11, and 25 are patentable over Ganjianpour. Pennig does not overcome the deficiencies of Ganjianpour because it does not disclose a shaft inserted into a bone of a patient and a replacement shaft where one shaft may be removed and replaced by the other shaft without removing the body from the patient. Accordingly, dependent claims 3-4, 14, 28-29, and 36-39, which depend from one of claims 1, 11, or 25, are also patentable and are presented for reconsideration and allowance.

**4. Claims 19-24**

Independent claim 19 is directed to a method of replacing a shaft of a joint prosthesis having a body, a head, and a shaft after the joint prosthesis has been implanted in a patient. The claim recites “removing the shaft from the patient without removing the body or the head” and “inserting a replacement shaft into the patient.” Applicant respectfully asserts that claim 19 and corresponding dependent claims 20-24 are patentable over either Ganjianpour alone or the combination of Ganjianpour and Pennig. In the Office Action, the Examiner did not specifically reject any of claims 19-24. Applicant respectfully requests an indication of allowance of claims 19-24.

**5. Conclusion**

Claims 1-41 are pending in the present application. Claims 1, 2, 7, 8, 11, 25, 27, 28, 34, 35, and 41 have been amended. Applicant believes that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date September 28, 2006

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